

Application No.: 09/909746
Docket No.: DC3138USNA

Page 4

REMARKS/ARGUMENTS

Restriction Requirement

As indicated by the Examiner, a telephone restriction requirement was made between the Examiner and Bob Stevenson on 12 September, 2003. A provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-20.

Applicant confirms that this election was made and is maintained at this time. However, Applicant cannot agree that the claims as grouped by the Examiner represent distinct inventions as proposed by the Examiner. In Applicant's opinion, the Group III claims should be maintained in the present application because the patentability of these claims relies on the composition of the Group I claims. The film of the release film on its own would not represent patentable subject matter and the patentability of the composition truly resides on the utility it has with respect to the film. For these reasons, Applicant believes that these two groups of claims should remain in this application.

As for the other Groups of claims, a similar argument can be made. In summary, Applicant traverses the restriction requirement and maintains a rejoinder to bring back the claims of the non-elected Groups back into the application upon allowance of the Group I claims.

Rejection of Claims 1 and 3 under 35 U.S.C. 112

The Examiner has rejected these claims as being indefinite. In particular, the Examiner has said that claim 1 is unclear due to the inclusion of hydroxypropyl methylcellulose having a hydroxypropyl degree of substitution of 0. The Examiner believes that with such a substitution level, the material would no longer be hydroxypropyl methylcellulose. In this regard, Applicant refers the Examiner to the description of the application, to Table I which appears after paragraph 0044 on page 8. In particular, Table I references the different grades of hydroxypropyl methylcellulose. The Examiner will note that the first entry in the table relates to Methocel® A and indicates that the hydroxypropyl molar substitution is 0. The Examiner will no doubt appreciate that Methocel® A is a commercial product available from the Dow Chemical Company and the designation relative to the hydroxypropyl molar substitution of 0 is understood to be a characteristic of that particular product. Thus, the Examiner's objection that the claim is improper because of the range given for the hydroxypropyl molar substitution is incorrect. In the circumstance, Applicant believes that the language of the claim is appropriate, since it is supported by the typical commercial

Application No.: 09/909746
Docket No.: DC3138USNA

Page 5

designations used by the supplier of this product. Applicant would respectfully submit that this rejection should be withdrawn.

In claim 3, Applicant has inserted the word "also" before "comprises" which clearly indicates that the high viscosity hydroxypropyl methylcellulose is present as an additional component and thus the up to 3% terminology should be acceptable. In the circumstance, the Examiner is respectfully asked to withdraw this rejection.

35 U.S.C. 102(b) Rejections

The Examiner has rejected the claims as being anticipated by U.S. Patent No. 4,429,120, or U.S. Patent No. 3,493,407.

As the Examiner will appreciate, claim 1 has been restricted so that it now defines a composition which comprises from about 0.2 to about 6.0% by weight of at least one hydroxypropyl methylcellulose having hydroxypropyl molar substitution of from 0 to about 0.82. Support for this limitation is found in the description at paragraph 0057 which appears at the top of column 4 in the published application. In addition to this change, Applicant has indicated that the solution is an aqueous solution and the solution includes from about 1% to about 35% by weight of alcohol. The Examiner indicates that U.S. Patent No. 4,429,120 anticipates previous claims 1, 3, 4, 5, 7 and 18-20 because Example 1 of the reference teaches hydroxypropyl methylcellulose having a hydroxypropyl degree of substitution of 0.1-0.3 having a 2% aqueous viscosity of 4000cps. The Examiner contends that the composition of the present claims is anticipated by the solution upon which viscosity is measured. Applicant fails to understand how the reference in an Example to a material which constitutes a starting material in the preparation of ethylhydroxyalkylmethylcellulose could constitute a disclosure of the composition of this invention. The patent in question teaches two ways of making ethylhydroxyalkylmethylcellulose. One route starts with cellulose and the other starts with HMPC such as methocels E, F, K and J. The Example describes a starting material which is subsequently manipulated to produce a different final result than that which is claimed in the present application. The citation at column 1, starting at line 61 references the desirability of producing a cellulose ether which is soluble in a wide variety of organic solvents and is thermoplastic. The present invention does not produce a thermoplastic product. The Examiner will note that additional ingredients mentioned in Example 1 include a fairly substantial amount of sodium hydroxide and ethyl chloride, which are not present in the currently claimed composition. Further, the resulting product is extremely different from the composition of the present invention as is also apparent from the description found at column

Application No.: 09/909746
Docket No.: DC3138USNA

Page 6

5, starting at line 20 wherein the uses of the cellulose ethers are described and these include use in gel lacquers, varnishes, hot melt compositions and the like, thickeners in organic systems such as textile printing inks and rotogravure printing inks, binders and printing pastes and printing inks, binders and delayed release coatings for pharmaceuticals and the like. These utilities are not envisaged by the present invention and it is not seen how the compositions of the present invention could be used for these purposes. Thus, Applicant cannot agree that this disclosure constitutes an anticipation of the present invention, and this is particularly true with respect to the amended claims wherein clear emphasis has been placed on the amount of hydroxypropyl methylcellulose present in the formulation and the nature of the aqueous solution in which it is contained. Thus, Applicant believes that the rejection of these claims on the basis of this patent, particularly the amended claims should be withdrawn and respectfully asks the Examiner to do so.

The Examiner has rejected claims 1, 2, 4-7, 9, 12 and 18-20 as being anticipated under U.S. Patent 3,493,407. In this regard, Applicant wishes to draw the Examiner's attention to the fact that claim 1 has been limited to the amount of from about 0.2 to about 6.0% by weight of the at least one hydroxypropyl methylcellulose. The amount of this substance is substantially less than is found in the cited U.S. patent. In this regard, the Examiner is referred to the description of the patent, found at column 1, starting at line 51 wherein the amount of cellulose ether is defined as being 10-30 weight percent and preferably 20-30 weight percent. Thus, since all of the claims are directly or indirectly appended to claim 1 which contains the limitation of the amount of hydroxypropyl methylcellulose, therefore all of the claims distinguish the invention over this citation. In the circumstance, Applicant believes that this reference should be withdrawn and respectfully asks the Examiner to do so.

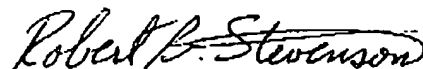
The Examiner further cited U.S. Patent No. 5,039,341 but has indicated that the tape joint compositions of this patent would not seem to be able to function as release compositions and therefore the disclosures of this patent would not appear to be relevant. In Applicant's opinion, the amended claims make this fact even more clear.

Application No.: 09/909746
Docket No.: DC3138USNA

Page 7

Favourable reconsideration of this application is respectfully requested.

Respectfully submitted,



ROBERT B. STEVENSON

Registration No.: 26,039

Telephone: (302) 992-6824

Facsimile: (302) 992-3257

FOR

CRAIG H. EVANS

ATTORNEY FOR APPLICANTS

Registration No.: 31,825

Telephone: (302) 992-3219

Facsimile: (302) 992-3257

Dated: March 08, 2004